01985-P0032A WWW/TMO

Appeal Brief
2-17-00
N. Pattie

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application Of   :

Bernard A. Weinstein et al.   :

                                         :   Examiner: Yves Dalencourt

Serial No.: 08/863,037   :

                                         :   Group Art Unit: 2735

Filed: May 23, 1997   :

For: MARKET DATA NOTIFICATION   :
       SYSTEM   :

Appeal Brief Under 37 C.F.R. §1.192

Commissioner for Patents
   and Trademarks
Washington, D.C. 20231

Dear Sir:

      Having filed herewith a Notice of Appeal from the final rejection of claims 1-4 and 11-17, all of the claims currently pending, the final rejection being mailed on January 10, 2000, Appellants submit their Appeal Brief for the above-captioned application pursuant to 37 C.F.R. §1.192 in triplicate as follows.

Real Party in Interest

The real party in interest is The Thomson Corporation residing at One Station Place, Stamford, Connecticut 06902. The Thomson Corporation is in the process of changing its name to Thomson Information Services, Inc., and new assignments are being filed with the Patent and Trademark Office.

Related Appeals and Interferences

There are no related appeals or interferences.

Status Of Claims

Claims 1-4 and 11-17, are currently pending, stand rejected and are the subject of the instant Appeal. A copy of each of these claims is attached hereto as Exhibit A.

Status Of Amendments

Subsequent to the Final Rejection being mailed on January 10, 2000, Appellants have not filed any Amendments.

Summary Of Invention

As described in the specification, Appellants disclose and claim a system 10 for providing notification of market information. A user computer 12 is used to specify a market condition to be monitored 15, which is received and stored on a host computer 30. Upon receipt of the condition to be monitored 15, the host

computer 30 generates and transmits confirmation data 17 indicating that the specified market condition 15 has been received by the host computer 30 and will be monitored. A monitoring program 24 compares each of the specified market conditions 15 stored on the host computer with a source of updated market data 20 to determine if a specified market condition 15 is found in the source of updated market data 20. If and when a specified market condition 15 is found to exist, the monitoring program 24 generates a signal 32 indicating such, and transmits the signal 32 to the client 36. See FIG. 1 of the subject patent application.

References Cited And Applied

U.S. Patent No. 5,787,402 to Potter.

U.S. Patent No. 5,270,922 to Higgins.

U.S. Patent No. 5,267,148 to Kosaka et al.

U.S. Patent No. 5,281,962 to Vanden Heuvel.

Grounds Of Rejection

Claims 1-2, 4, 11-12, and 15-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Potter in view of Higgins. Claim 14 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Potter in view of Higgins and further in view of Kosaka. Claims 3 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Potter in view of Higgins and further in view of Vanden Heuvel.

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Issues Presented For Review

Whether the combinations of references suggested by the Examiner render obvious the Appellant's invention when none of the references, either alone or in combination, discloses or suggests a confirmation generated and transmitted by a host computer system <u>upon receipt of a market condition to be monitored</u>, and a <u>separate</u> signal sent to a user if and when the specified market condition is found to exist, as required by all pending claims.

Grouping of Claims

The claims do not stand or fall together. The invention is claimed from several perspectives, each defining the invention in materially different terms.

Each of the independent claims defines the invention from a unique perspective. Claim 1 defines a system for providing notification of the occurrence of specified market conditions. Claim 11 defines such a system for providing notification of the occurrence of specified market conditions which is particularly adapted to be used with hand-held pager networks. Claim 15 defines a method for providing notification of the occurrence of specified market conditions.

Each of the dependent claims adds different elements to the novel combination of the independent claims. Each of these claims presents the invention from a different perspective than the independent claims. As such, all

claims must be considered because it is improper to fail to consider any limitation in the claims. In re Geerdes, 491 F.2d 1260, 1262, 180 U.S.P.Q. 789, the 791 (CCPA 1974) ("every limitation in the claim must be given effect rather than considering one in isolation from the others").

Argument

All three of Appellants' independent claims call for a system for providing notification of market information in which a user computer is used to specify a market condition to be monitored, which specified market condition is received and stored on a host computer. Upon receipt of the condition to be monitored, the host computer generates and transmits confirmation data indicating that the specified market condition has been received by the host computer and will be monitored. A monitoring program compares each of the specified market conditions stored on the host computer with a source of updated market data to determine if a specified market condition is found in the source of updated market data. If and when a specified market condition is found to exist, the monitoring program generates a signal indicating such, and transmits the signal to the client. For example, Claim 1 reads as follows:

> 1.   A system for providing notification of market information, which comprises:
>   ...
>   confirmation data generated and transmitted by said host computer system upon receipt of the specified market condition to be monitored and the corresponding client ID, said confirmation data indicating that the specified market condition has been received by said host computer and will be monitored;
>   a monitoring program executable on said host computer system ..., said monitoring program generating a signal if a specified market condition is found to exist, the signal indicative of

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> the found specified market condition and the corresponding client
> ID stored on said host computer system; and
>   a transmitter responsive to said signal for transmitting
> notification of the specified market condition.

Claim 1 (emphasis added).

Potter, on the other hand, discloses a method for performing financial transactions involving foreign currencies, particularly accommodating "leave orders." A user of the system disclosed in Potter specifies the terms of the transaction the user desires and then "leaves" the order with the system. The system monitors the market terms against the users desired terms and reports back to the user with a bank's offer if the conditions are met. If the offer is accepted, only then does the system automatically forward the trade for processing, generate reports, and allow the user to enter settlement instructions and receive confirmation of trade details. Thus, Potter teaches sending a confirmation only _after_ the user's desired terms are found to exist.

On the other hand, all claims require that confirmation data be generated and transmitted by the host computer system _upon receipt of the market condition to be monitored_, and then that a _separate_ signal be sent to the user if and when the specified market condition is found to exist. At most, Potter suggests only the second separate signal sent to the user after the market condition is found to exist. Nowhere does Potter teach or suggest that a confirmation be generated and transmitted upon receipt of a market condition to be monitored, as required by all claims.

Higgins discloses a system for distributing, processing and displaying financial information. A hierarchy of computers is provided cascading from a home office mainframe computer to area computers to branch computers down to individual workstations. Financial information is passed to a ticker plant from various exchanges, and then to the computer hierarchy. Each workstation has executing thereon a filtering program which filters the incoming financial information according to user specified criteria to determine if the information is to be displayed.

Like Potter, Higgins does not teach or suggest that a confirmation be generated and transmitted upon receipt of a market condition to be monitored, as required by all claims, and as such, the Examiner has not cited Higgins as teaching this limitation.

Kosaka discloses a system which displays information simultaneously between a dealer and a customer so that the dealer and the customer may consult while viewing the common information, and is cited by the Examiner only as teaching a system wherein a user computer includes a communication server. Vanden Heuvel discloses a device for automatic generation and notification of identification information corresponding to a received message, and is cited by the Examiner only as teaching supplying the market condition to be monitored in electronic mail format. Neither Kosaka nor Vanden Heuvel teach or suggest that

a confirmation be generated and transmitted upon receipt of a market condition to be monitored, as required by all claims.

Even combining the prior art discussed above, as suggested by the Examiner, would not render obvious the present invention as claimed. As discussed above, none of the prior art teaches or suggests that confirmation data be generated and transmitted by a host computer system upon receipt of a market condition to be monitored, and then that a separate signal be sent to a user if and when the specified market condition is found to exist. As such, a combination of the prior art would not result in a device having such characteristics. At most, any combination would result in a device which would send to the user only the second signal after the market condition is found to exist.
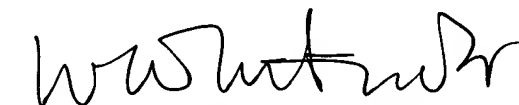
Conclusion

Appellants have made a significant advance over the prior art by providing a system which notifies a client when his request is received by a monitoring service's computer for monitoring. This is important because it may be a matter of minutes or it may take up to several hours for the monitoring service computer to receive the request from the user. Given the speed with which market conditions change, it is very important that the client know that his request is immediately received by the monitoring service's computer for monitoring so that he does not miss a market event of the type he wants to monitor. The invention achieves this result by providing confirmation data generated and transmitted by a host

computer system upon receipt of a market condition to be monitored, and then a separate signal sent to a user if and when the specified market condition is found to exist, which limitation is not disclosed nor suggested in the prior art. Accordingly, reconsideration and allowance of all the claims is believed in order, and such action is earnestly solicited.

Respectfully submitted,

February___, 2000

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Exhibit A - Pending Claims

1.   A system for providing notification of market information, which comprises:

a user computer for specifying a market condition to be monitored and a corresponding client ID;

an electronic source of updated market data;

a host computer system for receiving and storing a plurality of the market conditions specified for monitoring and the corresponding client IDs;

confirmation data generated and transmitted by said host computer system upon receipt of the specified market condition to be monitored and the corresponding client ID, said confirmation data indicating that the specified market condition has been received by said host computer and will be monitored;

a monitoring program executable on said host computer system for comparing each of the specified market conditions stored on said host computer system and said source of updated market data to determine if a specified market condition is found in said source of updated market data, said monitoring program generating a signal if a specified market condition is found to exist, the signal indicative of the found specified market condition and the corresponding client ID stored on said host computer system; and

a transmitter responsive to said signal for transmitting notification of the specified market condition.

2.   The system of Claim 1, further comprising a program executable on said user computer for providing share price momentum as a market condition to be monitored.

3.   The system of Claim 1, wherein said user computer specifies the market condition to be monitored in electronic mail format.

4.   The system of Claim 1, wherein said user computer is a financial representative's computer.

11.   A system for providing notification of market information receivable by a client, which comprises:

a user computer for specifying a market condition to be monitored and a corresponding client ID;

an electronic source of updated market data;

a host computer system including a database for receiving and storing a plurality of the market conditions specified for monitoring and the corresponding client IDs;

confirmation data generated and transmitted by said host computer system upon receipt of the specified market condition and corresponding client ID by said database, said confirmation data indicating that the specified market condition has been received by said host computer and will be monitored;

a monitoring program executable on said host computer system for comparing each of the specified market conditions stored on the database and said source of updated market data to determine if a specified market condition is found in said source of updated market data, said monitoring program generating a signal if a specified market condition is found to exist, the signal indicative of the found specified market condition and the corresponding client ID stored on the database; and

a transmitter responsive to said signal for transmitting notification of the specified market condition and the corresponding client ID to a paging network.

12. The system of Claim 11, further comprising a program executable on said user computer for providing share price momentum as a market condition to be monitored.

13. The system of Claim 11, wherein said user computer specifies the market condition to be monitored and the corresponding client ID in electronic mail format.

14. The system of Claim 11, wherein said user computer includes a communications server.

15. A method for providing notification of market information, which comprises the steps of:

providing a software program to a user for specifying a market condition to be monitored and a corresponding client ID;

receiving and storing a plurality of the specified market conditions to be monitored and the corresponding client IDs in a host computer system;

generating and transmitting confirmation data for receipt by the user when the specified market condition to be monitored and the corresponding client ID is received by said host computer system, the confirmation data indicating that the specified market condition has been received by the host computer and will be monitored;

comparing each of the specified market conditions stored on the host computer system with a source of updated market data to determine if a specified market condition is found to exist;

generating a signal if the specified market condition is found to exist indicative of the found specified market condition and the corresponding client ID on the host computer system; and

transmitting notification of the specified market condition in response to said signal.

16. The method of Claim 15, further comprising the step of specifying a client ID corresponding to the market condition specified to be monitored.

17.   The method of Claim 15, wherein the market condition specified to be monitored includes share price momentum.